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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/675,466	09/28/2000	Arnold N. Blinn	MS1-595US	8924
22801	7590	03/25/2004	EXAMINER	
LEE & HAYES PLLC 421 W RIVERSIDE AVENUE SUITE 500 SPOKANE, WA 99201			FELTEN, DANIEL S	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 03/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/675,466

Applicant(s)

BLINN ET AL.

Examiner

Daniel S Felten

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 28 September 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The prior art cited in the Information Disclosure Statement filed September 08, 2003 has been considered. Claims 1-34 are pending in the application and are presented to be examined upon their merits.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 3-5, 19-21, 24, 26-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The word "type" or "types" has connotations that change the scope of the claim since one of ordinary skill in the art would not be able to ascertain the parameters or the particulars of which "type" or "types" the applicant is referring to. It is therefore incumbent upon the applicant to present claim language that distinctly claims the subject matter in lieu of the specification.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The claimed invention is directed to non-statutory subject matter. Claims 11-16 and 19-31 present abstract ideas that do not show technical basis, because there is no claim language within the body of the claim(s) that shows how technology is being used to perform the various functions/steps within the claims. Moreover, if the invention in the body of the claim is not tied to technological art, environment, or machine, the claim is not statutory (see *Ex Parte Bowman*, 61 USPQ2d 1665,1671; see also MPEP 2106 IV (b))* . Therefore it is incumbent upon the applicant to provide claim language within the body of the claim that shows technical basis. Merely changing the preamble to recite technology does not overcome this rejection; technology must be recited within the body of the claim.

*Even though *Bowman* is not precedential, it can be cited for its analysis.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 11, 26 and 29-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Pitroda (US 5,590,038).

Re claim 11:

Pitroda presenting a plurality of accounts of different types to a user; and allowing the user to transfer value from one of the plurality of accounts to another of the plurality of accounts (see Pitroda, col. 6, ll. 62 to col. 7, ll. 31).

Re claim 26:

Pitroda discloses maintaining a plurality of different types of payment accounts for a user; and allowing the user to transfer payment information stored in the payment accounts to merchants to make purchases (see Pitroda, col. 3, ll. 62 to col. 4, ll. 11).

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Re claim 29:

Pitroda discloses allowing the user to transfer funds between different ones of the plurality of different types of payment accounts (see Pitroda, col. 14, ll. 39-49).

Re claim 30:

Pitroda discloses allowing additional funds to be added (deposited) to a payment account (see Pitroda, fig. 18 and 19, col. 14, ll. 39-49).

Re claim 31:

Pitroda discloses allowing additional funds to be added to the payment account comprises allowing additional funds to be added to the payment account by the user (see Pitroda, fig. 18 and 19, col. 14, ll. 39-49).

Re claim 32:

Pitroda discloses that the plurality of different types of payment accounts are maintained in an electronic wallet (UET) (see Pitroda, figs. 18 and 19, col. 14, ll. 32):

receiving a request from a merchant for information that is not included in the electronic wallet (see Pitroda, col. 13, ll. 39 to col. 14, ll. 32);

obtaining the requested information from the user; returning the requested information to the merchant (see Pitroda, col. 13, ll. 39 to col. 14, ll. 32; and col. 15, ll. 40+).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-10, 12-19, 23-25, 27, 28 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pitroda (Us 5,590,038) in view of Franklin et al (US 5,883,810).

Re claim 1:

Pitroda discloses that one or more computer readable media having stored thereon a plurality of instructions that, when executed by one or more processors, causes the one or more processors to perform acts (see Pitroda, Abstract):

identifying a plurality of accounts corresponding to the user (see Pitroda, col. 1, ll. 9-36; col. 2, ll. 44+; and col. 3, ll. 34-61);

selecting a subset of the plurality of accounts to make available to the user, the subset including only those accounts that can be used by the user to make a purchase at the merchant server (see Pitroda, col. 3, ll. 62 to col. 4, ll. 11); and

presenting the subset of accounts to the user (see Pitroda, col. 1, ll. 9-36; col. 2, ll. 44+; and col. 3, ll. 34-61).

Pitroda discloses an indication of a purchase a user is attempting to make via a status indication during a sales transaction, but fails to disclose receiving, from a merchant server. This is disclosed by Franklin (see Franklin col. 3, ll. 48+). It would have been obvious for an artisan of ordinary skill in the art at the time of the invention to be motivated to use the merchant server as disclosed in Franklin, because an artisan at the time of the invention would have recognized the advantages of the merchant server over the POS, to provide various status and transaction over the notoriously old and well known Internet. Thus to substitute the merchant server for the POS would have provided the latest network technology as well as an obvious expedient well within the ordinary skill in the art.

Re claim 2:

Pitroda discloses that the plurality of accounts include one or more of: credit card accounts, debit card payment accounts, gift certificate payment accounts, rebate payment accounts, reward payment accounts, and cash payment accounts (see Pitroda, col. 1, ll. 9-36).

Re claim 3:

Pitroda discloses that the accounts that can be used to make a purchase at the merchant server are those accounts of a type identified by the merchant server as well as additional accounts of a type that are mapped to an account type identified by the merchant server as being useable (see Pitroda, col. 13, ll. 47 to col. 14, ll. 32).

Re claim 4:

Pitroda discloses that the accounts that can be used to make a purchase at the merchant server are those accounts of a type identified by the merchant server as well as additional accounts of a type from which funds can be added to an account of a type identified by the merchant server (see Pitroda, figs. 18 & 19, col. 14, ll. 39-49).

Re claim 5:

Pitroda discloses that one or more computer readable media wherein the plurality of instructions further cause the one or more processors to perform acts including receiving, from the merchant server, the identification of types of accounts as part of the indication of the purchase the user is attempting to make (see claim 1).

Re claim 6:

Pitroda wherein the plurality of instructions further cause the one or more processors to perform acts including: receiving a user selection of one of the subset of accounts; and forwarding, to the merchant server, payment information corresponding to the selected account (see claim 1).

Re claim 7:

Wherein the plurality of instructions further cause the one or more processors to perform acts including:

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receiving a user selection of two or more of the subset of accounts;
allowing the user to combine funds from the selected accounts into a
combined account; and
forwarding, to the merchant server, payment information corresponding to the
combined account.

Re claim 8:

Pitroda discloses wherein the plurality of instructions further cause the one or more
processors to perform acts including allowing the user to combine funds from one
account that is not identified by the merchant as acceptable with another account that is
identified by the merchant as acceptable.

Re claim 9:

Pitroda wherein the plurality of instructions further cause the one or more processors to
perform acts including:

receiving a user selection of one of the subset of accounts;
mapping payment information corresponding to the account to a format that can
be used to make a purchase at the merchant server; and
forwarding, to the merchant server, the mapped payment information.

Re claim 10:

Pitroda discloses that one or more computer readable media wherein the plurality of accounts are identified in an electronic wallet UET (see Pitroda, figs. 12-14 and 19-24), and wherein the plurality of instructions further cause the one or more processors to perform acts including:

receiving, from the merchant server, a request for information not included in the electronic wallet (see Pitroda, col. 13, ll. 39 to col. 14, ll. 32);

querying the user for the information; receiving a response to the query;

returning the response to the merchant server as the requested information (see claim 1, and col. 13, ll. 39 to col. 14, ll. 32, also col. 15, ll. 40+).

Re claim 12:

Pitroda discloses storing the plurality of accounts in an electronic wallet on a remote server (see Pitroda, col. 11, ll. 40+; and col. 14, ll. 40-65).

Re claim 13:

Pitroda discloses wherein the different types of accounts include two or more of debit card payment accounts, gift certificate payment accounts, rebate payment accounts, reward payment accounts, allowance payment accounts, and cash payment accounts (see Pitroda, col. 14, ll. 8-49).

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Re claim 14:

Pitroda discloses wherein the allowing comprises allowing the user to transfer value from one of the plurality of accounts to another of the plurality of accounts while in the process of making an on-line purchase (see Pitroda, col. 14, ll. 8-49).

Re claim 15:

Pitroda discloses wherein the allowing further comprises allowing the user to transfer value from an account that is not accepted by a merchant at which the on-line purchase is being made to an account that is accepted by the merchant (see Pitroda, col. 14, ll. 8-49).

Re claim 16:

Pitroda discloses that one or more computer-readable memories containing a computer program that is executable by a processor to perform the method recited in claim 11 (see Pitroda, Abstract; and col. 12, ll. 7+).

Re claim 17:

A system comprising:

a wallet server to store a plurality of payment accounts for a user; and
a user interface component, coupled to the wallet server, to display the plurality of payment accounts and to allow manipulation of the payment accounts including transferring value from one payment account to another (see Pitroda, col. 10, ll. 9+).

Re claim 18:

Pitroda in view of Franklin discloses a system wherein the user interface component comprises a web page (see Franklin, col. 6, ll. 12+).

Re claim 19:

Pitroda in view of Franklin discloses receiving a request from a user to make a purchase using a particular type of fund;

converting payment information corresponding to the particular fund to a credit card format; and communicating the converted payment information to a merchant for the purchase (see Pitroda, col. 1, ll. 9-36).

Re claims 22 and 24:

Pitroda in view of Franklin discloses converting the payment information to the credit card format without the user's knowledge; and communicating the converted payment information to the merchant without any indication of the conversion from the particular type of fund (see Pitroda, col. 2, ll. 44+)

Re claim 23:

Pitroda in view of Franklin discloses that converting comprises converting the payment information to a Visa® credit card format (see Pitroda, col. 11, ll. 39-58).

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Re claim 25:

Pitroda in view of Franklin discloses that one or more computer-readable memories containing a computer program that is executable by a processor to perform the method recited in claim 19 (see Pitroda, col. 12, ll. 7+).

Re claim 27:

Pitroda discloses wherein the types of payment accounts include one or more of debit cards, gift certificates, rebates, allowances, and cash (see Pitroda, col. 1, ll. 9-36).

Re claim 28:

Pitroda discloses that the maintaining comprises maintaining the plurality of different types of payment accounts at a remote server (see claim 1).

Re claim 33:

Pitroda discloses that one or more computer-readable memories containing a computer program that is executable by a processor to perform (see Pitroda, col. 12, ll. 7+).

9. Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pitroda as modified by Franklin et al as applied to claim 1, and in further in view of Christensen et al (US 5,710,886). The teachings of Pitroda as modified by Franklin et al have been discussed above.

Re claims 20 and 21:

Pitroda as modified by Franklin discloses various funds/ accounts, but fails to disclose that the particular type of fund comprises a gift certificate and/or rebate funds. This is disclosed by Christensen (see Christensen, Abstract). It would have been obvious for an artisan of ordinary skill at the time of the invention to employ the teachings of Christensen to the teachings of Pitroda as modified by Franklin because an artisan would have recognized that gift certificates and rebates are notoriously old and well known in the art to encourage card users to make additional purchases. Thus an artisan would have been motivated to use the gift certificate fund and rebate fund as a purchase incentive to the cardholder, thus creating greater use of the card. Thus such a modification would have been an obvious expedient well within the ordinary skill in the art.

Re claim 34:

Pitroda as modified by Franklin fails to disclose maintaining a gift certificate account including payment information corresponding to the gift certificate account, presenting, to the user, the gift certificate account as a gift certificate and presenting, to a merchant, the gift certificate account as a credit card. This is disclosed by Christensen (see explanation for claims 20 and 21)

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patents:

Pitroda (US 5,590,038) discloses a universal electronic transaction card including receipt storage and system and methods of conducting electronic transaction

Christensen et al (US 5,710,886) discloses electric couponing method and apparatus

Gutman et al (US 5,221,838) discloses electronic wallet

Flitcroft et al (US 6,636,833) discloses credit card system and method

Kraemer (US 6,490,602) discloses a method and apparatus for providing enhanced functionality to product web pages

Weber (US 5,889,863) discloses a system, method and article of manufacture for remote virtual point of sale processing utilizing.

Pitroda (US 5,590,038) discloses universal electronic transaction card including receipt storage and system and methods of conducting electronic transactions

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S Felten whose telephone number is (703) 305-0724. The examiner can normally be reached on Flex.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DSF
March 18, 2004

Daniel S Felten
Examiner
Art Unit 3624